JUL 5 1950
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. 182

LEWYT CORPORATION,
Petitioner,

vs.

HEALTH-MOR, INC. and EDWARD H. YONKERS, JR.,
Respondents.

PETITION FOR WRIT OF CERTIORARI.

CARLTON HILL,
CASPER W. OOMS,
Attorneys for Petitioner.

DAVID S. KANE,
SAMUEL W. KIPNIS,
Of Counsel.

July 3, 1950.

THE GUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

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No. .....

LEWYT CORPORATION,

Petitioner,

vs.

HEALTH-MOR, INC. and EDWARD H. YONKERS, JR.,

Respondents.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and the Associate Justices of the Supreme C[illegible] of the United States:

Petitioner prays that a w[illegible] of certiorari issue to review the judgment entered by the United States Court of Appeals for the Seventh Circuit (R. 351), wherein the Court reversed 85 U. S. P. Q. 335 (R. 342) the decision of the trial Judge Hon. William H. Holly, U. S. D. C., N. D. Ill., 84 F. Supp. 189 (R. 247).

The judgment relates to Yonkers Patent No. 2,198,568 (R. 214) for a replaceable filter canister type vacuum cleaner.

The District Court (R. 249) held invalid and not infringed all claims in suit. The Court of Appeals reversed (R. 351), finding infringement of Claims 2, 4 and 7 by

resorting to the doctrine of equivalents, and of Claim 8, which does not embody the very element which the Court of Appeals found to be the essential element of novelty. The Court disregarded the doctrine of file wrapper estoppel and gave the claims their pre-amended scope (R. 348-9) and disregarded the District Court's findings of lack of invention and anticipation (R. 345-6).

The case presents the problem whether cancelled and abandoned claims may be revived by resorting to the doctrine of equivalents and whether a court of appeals may treat the lower court's findings of non-invention and anticipation as no more binding than the presumption of validity arising from the patent grant.

JURISDICTION.

This Court has jurisdiction to review said judgment under Sections 1254 (1) and 2101 (c) of the new Judicial Code.

The judgment was entered May 4, 1950 (R. 351). Petition for rehearing, duly filed (R. 351), was denied June 3, 1950 (R. 352).

MATTER INVOLVED.

Petitioner was forced to bring this declaratory judgment action by respondent's tactics in threatening, but not suing, petitioner's customers with patent infringement suits under three patents (R. 2-8). At the trial, respondent admitted that one[1] was not infringed and it was dismissed (R. 247). The other two[2] were held invalid and not infringed (R. 265). Respondent then appealed only from so much of the judgment as adjudged Yonkers Claims 2, 4, 7 and 8 invalid and not infringed (R. 266). The Court of Appeals reversed (R. 351).

The application for the Yonkers patent disclosed, in its specification and drawings, a cleaner in which a conical paper filter is held in place by a perforated metal support, and an air inlet into the dust compartment terminates in a nozzle positioned "adjacent to and parallel with" the conical paper filter (R. 142, 146).

When the application was filed, all claims to the cleaner were broad in defining the relationship between the air intake and the filter as "an air intake * * * below * * * said filter" (R. 148-151)[3] but, pursuant to rejection (R. 155), the claims were cancelled or amended (R. 156, 163, 167, 185, 194). Meanwhile, original Claim 20 (R. 156), renumbered as Claim 35 (R. 188), which, after several amendments became issued Claim 2 of the patent (R. 188), was added. In this claim the distance or relationship between the nozzle and the filter was clearly limited as one in which the nozzle was "adjacent to and parallel with the filter surface" (R. 179).

(1) U. S. Patent No. 2,296,359.

(2) U. S. Patents Nos. 2,280,495 and 2,198,568.

(3) Of these, original Claims 9 and 10 (R 149) are typical.

This limitation was necessary because all other features of the cleaner were old. This is clear from the drawings from the patent in suit and the prior art and that of the accused structure attached to the back cover of this brief.

The vital amendment made to the claims as the price of their allowance by the Patent Office is manifest by the comparison of allowed claim 2 with original claim 9 reproduced on the chart attached to the back cover of this brief.

Later, Yonkers added Claim 40, which became Claim 4 of the patent (R. 194), and Claim 45, which became Claim 7 of the patent (R. 202). Both of these claims contain the limiting amendment.

Yonkers argued in the Patent Office that that particular relationship was vital (R. 197-9) and it became the basis of the grant (R. 201).

Petitioner's air intake, in contrast to that shown in Yonkers, does not terminate in a nozzle positioned adjacent to and parallel with the filter surface. Petitioner's air intake discharges the air **neither adjacent to nor parallel with** the filter surface, but rather introduces such air adjacent the outer side wall of the dust compartment as far away from the filter surface as is possible (R. 41). In so doing, petitioner follows the prior art patents to Kirby (R. 290) or Upton (R. 308), in which the air intake is just as far away from the filter as possible. In the Patent Office the patentee distinguished his structure from these earlier patents by the special form of air intake nozzle and its location "adjacent to and parallel with" the filter (R. 197-9).

Decisions of the Courts Below:

The District Court held (R. 262-265) the Yonkers claims invalid for want of invention and not infringed. The Court of Appeals reversed and accorded the claims a wide range of equivalents, notwithstanding that, in so holding, the

Court of Appeals, in effect, enlarged Claims 2, 4 and 7 to the scope of rejected and cancelled claims (R. 348-9). The cancelled claims read directly on petitioner's cleaner; Claims 2, 4 and 7 do not.

Thus, the Court of Appeals has held that the doctrine of equivalents permits enlargement of the scope of a patent monopoly beyond the verbal bounds of the claims, notwithstanding that to secure the allowance of the claims the patentee was compelled to restrict them in the very respect in which they were enlarged by the Court of Appeals in order to encompass petitioner's cleaner.

The Court of Appeals predicated its finding of invention upon the form and cooperation between the air intake and the filter. Claim 8 omits completely the air intake which the Court of Appeals found to be an essential element of this combination.

The Court of Appeals refused to give effect to the findings of fact of the trial Court as required by Federal Rule 52(a). It set aside such findings with the observation that the finding of anticipation is no more conclusive upon the Court of Appeals than was the issuance of the patent upon the District Court (R. 345-6).

The findings of the District Court were based upon prior patents and physical exhibits in evidence (R. 280-316), upon the conflicting testimony of patent experts (R. 28-68; 83-97)[4] and scientific demonstrations in open court (R. 43).

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(4) Petitioner's patent expert disagreed with respondents' patent experts on many points (Compare R. 41, 57 with R. 80, 94, 110-113). The District Court accepted the testimony of petitioner's expert (R. 247-253).

QUESTIONS PRESENTED.

1. Where the applicant cancels claims broadly covering a certain combination, after rejection of such claims on prior art, and secures the allowance of new claims limited to a specific arrangement of the parts by persuading the Patent Office to allow the claims on the ground that such specific arrangement was the feature which distinguished the invention from the prior art, can the patentee avoid the estoppel which he has thus created and maintain that the allowed narrow claims cover a structure which lacks the distinguishing feature and would have been covered by the rejected and cancelled claims?

2. Is the public entitled to rely on the doctrine of file wrapper estoppel in designing new structures to avoid infringement of an issued patent?

3. Is a patent claim valid where it omits what the court found to be the essential element of patentable novelty?

4. Where the District Court entered findings of fact based on conflicting testimony of patent experts, scientific demonstrations in open court and documentary and physical exhibits, may the Court of Appeals treat such findings as no more conclusive upon that Court than was the issuance of the patent upon the District Court?

REASONS RELIED ON FOR ALLOWANCE OF WRIT.

The reasons relied on for the issuance of the writ prayed for are:

1. **The possibility of conflict between circuits is remote** despite the doubtful validity of the patent. Petitioner is respondent's only competitor in the field of replaceable filter canister type cleaners. Accordingly, the possibility of further litigation to settle the validity of the patent is remote. (See appended affidavits of George H. Scott, Alex M. Lewyt and David S. Kane.) This alone warrants review by this Court for the reasons pointed out in *Mackay Radio & Telegraph Co.* v. *Radio Corporation of America* (1939), 306 U. S. 86, 89; *Muncie Gear Works, Inc.* v. *Outboard Marine & Manufacturing Co.* (1942), 315 U. S. 759, 765-6; *Exhibit Supply Co.* v. *Ace Patents Corporation* (1942), 315 U. S. 126, 128; *Schriber-Schroth Co.* v. *Cleveland Trust Co.* (1938), 305 U. S. 47, 50.

2. The decision of the Court of Appeals reversing the District Court is in direct conflict with the decisions of this Court. Thus,

(a) To find infringement the Court below read Claims 2, 4 and 7 to cover what was eliminated from the patent grant by the cancellation of broad claims initially presented. This does not accord with the decisions of this Court in *Schriber-Schroth Co.* v. *Cleveland Trust Co.* (1940), 311 U. S. 211, 218, 220-2; *Altoona Publix Theatre* v. *Tri-Ergon Corp.* (1935), 294 U. S. 477, 487, 492; *Exhibit Supply Co.* v. *Ace Patents Corporation* (1942), 315 U. S. 126, 136-7; *Sutter* v. *Robinson* (1886), 119 U. S. 530, 541. Such revival of cancelled claims is clearly contrary to the public interest;

(b) The Court below sustained Claim 8 despite the fact that a feature found by the Court to be an essential element of the patented combination was not included in that claim. This is in direct conflict with the decisions of this Court in *Permutit Co.* v. *Graver Corp.*, 284 U. S. 52; *Schriber-Schroth Co.* v. *Cleveland Trust Co.* (1940) 311 U. S. 211, 217. **This very question is before this Court in The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. (No. 32, October Term, 1949) to be argued next October.**

3. **The Court below has departed from the accepted course of judicial proceedings** by treating findings of fact as entitled to no greater weight than the presumption of validity arising from the patent grant. This is in direct conflict with the decisions of this Court in *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products Co.* (1949), 336 U. S. 271, 274-5; on rehearing 85 U. S. P. Q. 328; *Lavender* v. *Kurn* (1946), 327 U. S. 645, 653.

4. Unless this Court clarifies the important question of file wrapper estoppel presented by the decision of the Court of Appeals in this case, it will be impossible for the public at large or counsel representing them to know when to proceed with new designs where the use of alleged equivalents to a patented structure is involved.

WHEREFORE, it is respectfully submitted that the writ should issue.

Respectfully submitted,

CARLTON HILL,
CASPER W. OOMS,
Attorneys for Petitioner.

DAVID S. KANE,
SAMUEL W. KIPNIS,
Of Counsel.

July 3, 1950.

IN THE

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No. .....

LEWYT CORPORATION,

Petitioner,

vs.

HEALTH-MOR, INC. and EDWARD H. YONKERS, JR.,

Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

The writ should issue to free the public of the unjust monopoly which the Court of Appeals has awarded to respondents in reviving rejected and cancelled claims by recourse to the doctrine of equivalents.

OPINIONS BELOW.

The opinion of the District Court is found at R. 247. It is reported in 84 F. Supp. 189.

The District Court's findings of fact and conclusions of law are found at R. 262-265.

The opinion of the Court of Appeals (R. 342) is reported in 85 U. S. P. Q. 335.

JURISDICTION.

As noted in the petition, jurisdiction is invoked under Sections 1254 (1) and 2101 (c) of the Judicial Code.

STATEMENT OF FACTS.

The facts are stated in the petition.

SPECIFICATION OF ERRORS.

The Court of Appeals erred:

1. In failing to hold that respondents were estopped by their conduct in the Patent Office from contending that Petitioner's cleaner is within the scope of claims 2, 4 and 7 of the Yonkers patent;

2. In bringing within the scope of claims 2, 4 and 7 structures abandoned by the patentee by application of the doctrine of equivalents where there was a file wrapper estoppel;

3. In holding valid and infringed claim 8 which makes no mention of the feature found by the Court of Appeals to be the essential element of novelty lending patentability to the claims;

4. In setting aside findings of fact based upon conflicting testimony and demonstrations in open court.

ARGUMENT.

I.

REASONS RELIED ON FOR ALLOWANCE OF THE WRIT.

This Court should grant the writ prayed for because:

1. No Possibility of Conflict Between Different Circuits.

The trial Court held the patent claims in suit invalid for lack of invention and not infringed. The Court of Appeals reversed. Despite the fact that the two courts have thus disagreed as to the validity and infringement of a patent, which quite clearly is of doubtful validity, the possibility of further litigation and conflict of decision between the circuits is remote. Although the device involved is a household appliance, potentially useful in every home, the parties to this suit are the only ones engaged in the business of manufacturing and selling it in the United States. Lewyt Corporation remains the only competitor in this field. (See appended affidavits of George H. Scott, Alex M. Lewyt and David S. Kane.) The judgment, therefore, is likely to foreclose all further inquiry into the validity of the Yonkers patent in suit.

These circumstances properly should result in the allowance of the writ. The Court so pointed out in:

Mackay Radio & Telegraph Co. v. *Radio Corporation of America* (1939), 306 U. S. 86, 89.

Muncie Gear Works, Inc. v. *Outboard Marine & Manufacturing Co.* (1942), 315 U. S. 759, 765-6.

Exhibit Supply Co. v. *Ace Patents Corporation* (1942), 315 U. S. 126, 128.

Schriber-Schroth Co. v. *Cleveland Trust Co.* (1938), 305 U. S. 47, 50.

Not only are the questions raised of large public importance and the patent doubtful, but, as in *Mackay Radio & Telegraph Co.* v. *Radio Corporation of America* (1939), 306 U. S. 86, the only competitor left to make the challenge is Lewyt. There the Court said (p. 89):

> "We granted certiorari * * * because of the nature and importance of the case, on a petition which urged as grounds for its allowance that validity and infringement * * * were in doubt and that, as petitioner is the only competitor of respondent * * * further litigation, resulting in conflict of decision among circuits, was improbable."

The writ should likewise issue here.

II.

THE DECISION OF THE COURT OF APPEALS REVERSING THE DISTRICT COURT IS IN DIRECT CONFLICT WITH DECISIONS OF THIS COURT.

1. The Court of Appeals has revived claims rejected and cancelled.

The Court of Appeals, in conflict with earlier decisions of this Court, revived rejected and cancelled claims by resorting to the doctrine of equivalents and found infringement by a structure abandoned by the patentee. Coming on the heels of this Court's decision in *Graver Tank & Mfg. Co.* v. *Linde Air Products,* 85 U. S. P. Q. 328, the failure of this Court to correct this situation is likely to place the long settled doctrine of file wrapper estoppel in doubt with injurious consequences to the public.

Claims 2, 4, and 7 are expressly limited to a replaceable filter canister type cleaner wherein the nozzle is positioned "adjacent to and parallel with the filter." This is because the claims initially presented called for "an air intake * * * below * * * the filter" and in compliance with

the requirements of the Patent Office, Yonkers cancelled those original claims and limited them to an arrangement in which the air intake terminated in a nozzle "adjacent to and parallel with the filter."

When Yonkers cancelled the original claims he recognized that in the prior art patents to Kirby (R. 290) and Upton (R. 308) the air intake was positioned below the filter, as it is in petitioner's cleaner. Yonkers cancelled those claims and in submitting the new claims (now patent Claims 2, 4 and 7) argued that the particular positioning of the nozzle with respect to the filter was vital and was the fact which distinguished the claims from the prior art (R. 197-198). He specifically pointed out that in the Upton prior patent "the intake nozzle is shown as being a substntial distance away from the filter surface." The fact is that in petitioner's cleaner the air intake is even further away from the filter surface than in the Upton patent (R. 36).

But the Court of Appeals disregarded the file history and completely overlooked the fact that claims reading directly on petitioner's cleaner were rejected on the earlier patents, then cancelled and abandoned, whereas the claims in suit do not read directly on petitioner's cleaner and can be made to cover petitioner's cleaner only by resorting to the doctrine of equivalents and ignoring the limitations which the Patent Office compelled the patentee to insert in his claims as the price of their allowance.

Moreover, if by resorting to the doctrine of equivalents, Claims 2, 4 and 7 are construed to cover petitioner's cleaner, they likewise read on the prior art Kirby or Upton cleaners wherein the air intakes are positioned closer to the filter than in petitioner's cleaner.

A claim once abandoned cannot be reviewed. Such has been the law as declared by this Court for over 60 years. The claim, having been abandoned, in order to obtain the

patent, *Sutter* v. *Robinson* (1886), 119 U. S. 530, the patentee (P. 541):

> "is not at liberty now to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow as a condition of the grant."

The Court has consistently applied the same rule ever since. In *Schriber-Schroth Co.* v. *Cleveland Trust Co.* (1940), 311 U. S. 211, the Court said (p. 218):

> "Where the patentee in the course of his application in the patent office has, by amendment, cancelled or surrendered claims, those which are allowed are to be read in the light of those abandoned and an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed."

The Court made it clear that the rule may not be evaded by recourse to the doctrine of equivalents in *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126. The Court said (P. 137):

> "It follows that what the patentee, by a strict construction of the claim, has disclaimed—conductors which are carried by the table but not embedded in it—cannot now be regained by recourse to the doctrine of equivalents, which at most operates, by liberal construction, to secure to the inventor the full benefits, not disclaimed, of the claims allowed."

What this Court says may not be done, the Court of Appeals has done. It reversed and restored to the patent the very claims which were cancelled and abandoned in order to distinguish from the prior art. The result is that both the Upton and Kirby constructions, now in the public domain, and petitioner's cleaner are brought within the scope of the Yonkers claims in spite of the patentee's agreement with the Patent Office that he was not entitled to claims of that scope.

2. The Court of Appeals has sustained a claim which does not mention the element found to be essential.

The Trial Court found that the Yonkers claims did not involve invention and were anticipated. The Court of Appeals reversed and predicated patentable novelty upon the feature of "form of and cooperation between the air intake and the replaceable conical paper filter" (R. 346). That feature is not mentioned in Claim 8. Hence, Claim 8 is clearly invalid. *Permutit Co.* v. *Graver,* 284 U. S. 51, 58; *Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 311 U. S. 215. **This very question is before this Court in The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. (No. 32, October Term, 1949) to be argued next October.**

III.

THE COURT HAS DEPARTED FROM THE ACCEPTED COURSE OF JUDICIAL PROCEEDINGS.

The Court of Appeals set aside findings of fact of the trial court upon the issues of invention and anticipation with the comment (R. 345-6):

> "However, it is to be observed that the finding of anticipation is, in this case, no more conclusive upon this Court than was the issuance of the patent upon the District Court for it was made on the basis of documentary evidence which is now before this Court and which this Court is free to interpret for itself in determining whether the finding is correct."

The Court of Appeals overlooked the fact that the District Court's findings of fact were not based upon documentary evidence alone. The trial court heard the testimony of experts and witnessed scientific demonstrations. It was upon all the evidence that the trial court's findings were based.

There was substantial evidence to support the District Court's findings and, although conflicting testimony was offered,[5] the District Court accepted the testimony of petitioner's expert.

It is firmly established that the trial court's findings should not be set aside unless clearly erroneous (Rule 52(a) F. R. C. P.) and

> "* * * due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

This Court held in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 275:

> "The rule requires that an appellate court make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony and reverse only 'clearly erroneous' findings."

And in the same case on rehearing, *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 85 U. S. P. Q. 328, this Court said:

> "It is not for this Court to essay an independent evaluation of this evidence. This is the function of the trial court."

The Court of Appeals failed to apply the law as declared by this Court. It tried this case *de novo*. Moreover, it disregarded the testimony of the patent experts. This is clear error.

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5. R. 41, 57, 80, 94, 110-113.

CONCLUSIONS.

We respectfully submit that the decision of the Court of Appeals for the Seventh Circuit is in direct conflict with applicable decisions of this Court and is inconsistent with the policy of the patent laws of importance not only to petitioner but to the public.

It is respectfully urged that the writ should issue.

Respectfully submitted,

CARLTON HILL,
CASPER W. OOMS,
Attorneys for Petitioner.

DAVID S. KANE,
SAMUEL W. KIPNIS,
Of Counsel.

July 3, 1950.

AFFIDAVIT IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

STATE OF OHIO,
COUNTY OF CUYAHOGA. } ss.

George H. Scott, being duly sworn, deposes and says:

That he is of legal age, a resident and citizen of the City of Cleveland, County and State aforesaid, and is President of the Vacuum Cleaner Manufacturers Association having its principal office in the City of Cleveland, County and State aforesaid, an association composed of members whose business is that of manufacturing and selling vacuum cleaners;

That he is familiar with all vacuum cleaners now manufactured and sold and that the only cleaners of the character involved in this litigation, to wit, utilizing a conical paper filter, are those made by the petitioner, Lewyt Corporation, Brooklyn, New York, in the Second Judicial Circuit of the United States and respondent, Health-Mor, Inc., Chicago, Illinois, in the Seventh Judicial Circuit of the United States.

/s/ GEORGE H. SCOTT.

Sworn to and subscribed before me this 23rd day of June, 1950.

/s/ W. J. MONTANARY,
Notary Public.

(SEAL)

My Commission expires July 25, 1950.

AFFIDAVIT IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

STATE OF NEW YORK, }
COUNTY OF KINGS. } ss.

Alex M. Lewyt, being duly sworn, deposes and says:

That he is of legal age, a resident and citizen of the City of New York, County of New York and State aforesaid and is President of Lewyt Corporation, respondent herein;

That he is familiar with all of the vacuum cleaners now being manufactured and sold in the United States and that the only vacuum cleaners of the character involved in this litigation, to wit, those employing a conical paper filter, are manufactured and sold by petitioner, Lewyt Corporation, in Brooklyn, New York, within the Second Judicial Circuit of the United States and respondent, Health-Mor, Inc., of Chicago, Illinois, within the Seventh Judicial Circuit of the United States.

/s/ ALEX M. LEWYT.

Subscribed and sworn to before me this 23 day of June, 1950.

/s/ MADGE L. FERREDY,
Notary Public.

(SEAL)

Madge L. Ferredy
Notary Public for the State of New York
Qualified in New York County No. 31-1200000
Cert. filed in Kings County

Commission expires March 30, 1951.

AFFIDAVIT IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

STATE OF NEW YORK,
COUNTY OF NEW YORK. } ss.

David S. Kane, being duly sworn, deposes and says:

That he is of legal age, a resident and citizen of the City of New York, County and State aforesaid and is an Attorney-at-Law and Counsel for Petitioner in the above case;

That prior to filing this action in the United States District Court for the Northern District of Illinois, Eastern Division, your affiant made a diligent investigation to ascertain whether the Respondents herein, Health-Mor, Inc., and Edward H. Yonkers, Jr., were subject to the jurisdiction of any other United States District Court. As a result of that investigation affiant is of the opinion and therefore asserts that the only federal district in which suit may be filed against the Respondents herein is the Northern District of Illinois, Eastern Division, within the Seventh Judicial Circuit of the United States.

DAVID S. KANE.

Sworn to and subscribed before me this 26th day of June, 1950.

VLASTA L. KNAKAL,
Notary Public.

(SEAL)

Vlasta L. Knakal
Notary Public, State of New York
No. 31-7309400
Cert. filed in N. Y. Co. Reg.
Residing in New York County

Commission expires March 30, 1952.

In a suction cleaner, a housing having a dust compartment in the bottom thereof,	In a suction cleaner, a housing having a dust compartment in the bottom thereof,
a generally conical air filter forming the top cover of said compartment with the apex of the cone extending inwardly toward the bottom of said compartment,	an air filter* of long fiber unsized paper having a smooth surface covering said compartment,
said filter comprising a perforated supporting member and a flexible filtering member against said supporting member,	a perforated member disposed above said filter for supporting the same against collapse,
an intake connection into said dust compartment below said filter,	and air intake and
said intake connection terminating in a nozzle for discharging dirt-laden air adjacent to and parallel with the filter surface and	
an exhaust connection above said filter.	exhaust connections below and above said filter respectively.

* Original claim 10, also rejected and cancelled, added only that the filter is "conical".

R. 156, 188, 216 R. 149

ORIGINAL CLAIMS 9 AND 10 WERE REJECTED AND CANCELLED ALTHOUGH THEY DIFFERED FROM ALLOWED CLAIM 2 SUBSTANTIALLY ONLY IN THE DEMAND THAT THE INTAKE TERMINATE IN A "NOZZLE * * * ADJACENT TO AND PARALLEL WITH THE FILTER SURFACE", A FEATURE ENTIRELY ABSENT FROM THE STRUCTURES HELD TO INFRINGE.

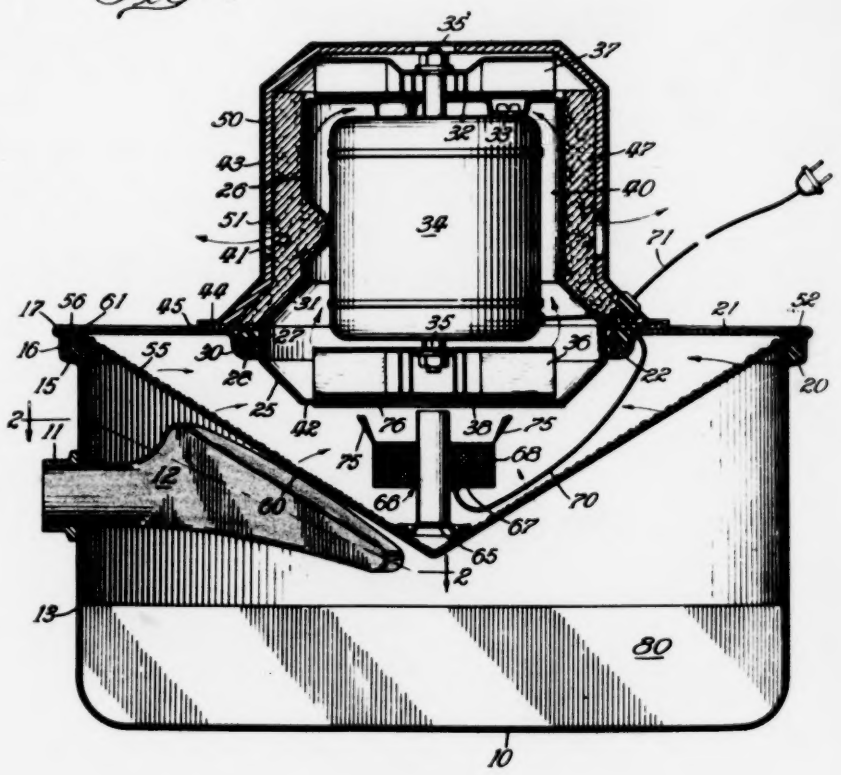
THE PATENT IN SUIT WAS ALLOWED ONLY AFTER CLAIMS WERE SPECIFICALLY LIMITED TO REQUIRE THAT THE INTAKE NOZZLE BE ADJACENT TO AND PARALLEL WITH THE FILTER SURFACE, THE ONLY FEATURE NOT SHOWN BY THE PRIOR ART, BUT THIS LIMITATION, DEMANDED BY THE PATENT OFFICE, WAS COMPLETELY IGNORED BY THE COURT OF APPEALS, AND THE DOCTRINE OF FILE WRAPPER ESTOPPEL THUS COMPLETELY THWARTED.

E. H. YONKERS, JR.

SUCTION CLEANER

Filed Sept. 8, 1937

Fig 1



THE PATENT IN SUIT SHOWS
THE INTAKE NOZZLE
"ADJACENT TO AND PARALLEL WITH
THE FILTER SURFACE"
(R. 214)

VACUUM CLEANER.

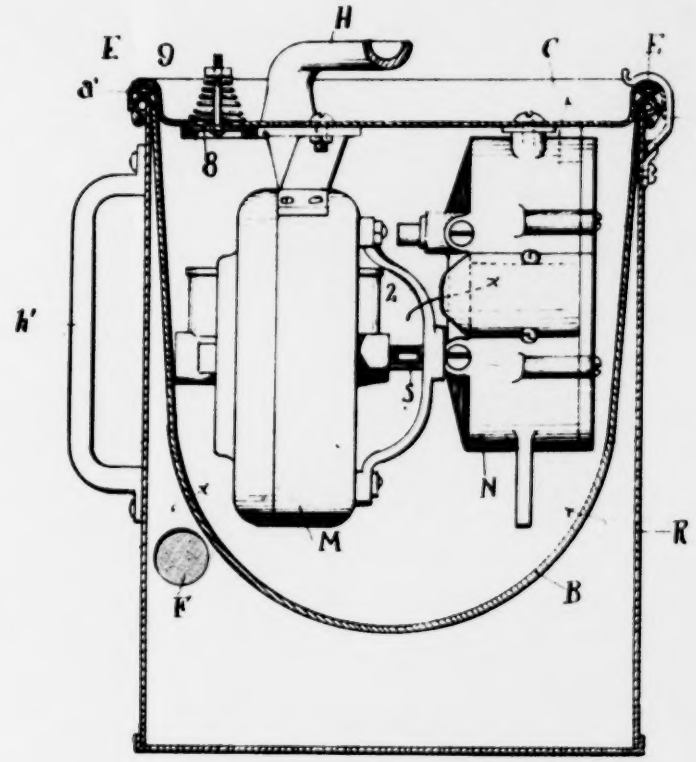
APPLICATION FILED JULY 9, 1909. RENEWED JAN. 10, 1914.

1,100,575.

Patented June 16,

2 SHEETS

Fig. 1.

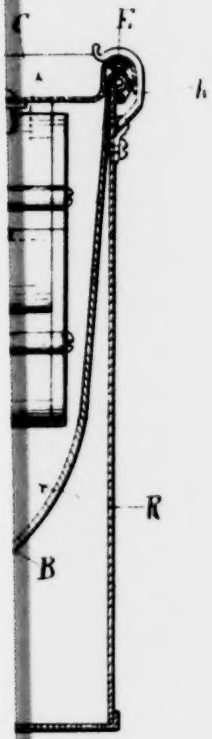


R. 290

10, 1914

Patented June 16, 1914

2 SHEETS SHEET

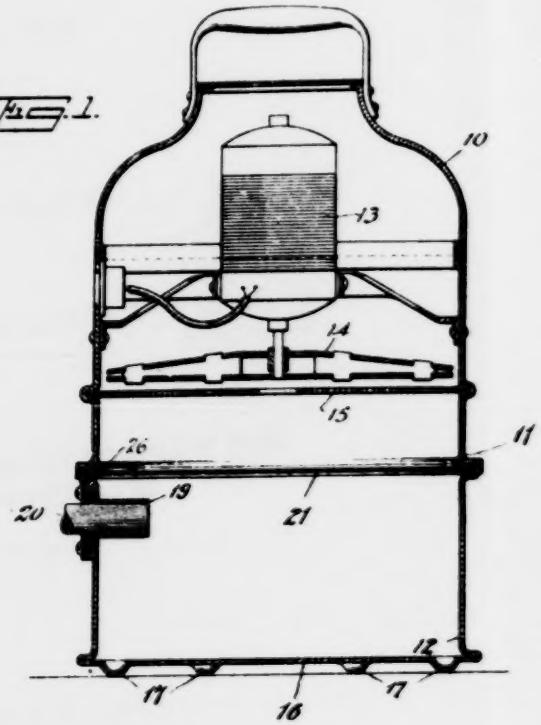


Jan. 13, 1931. W. H. UPTON 1,789,203

VACUUM CLEANER

Filed April 10, 1929

Fig. 1.

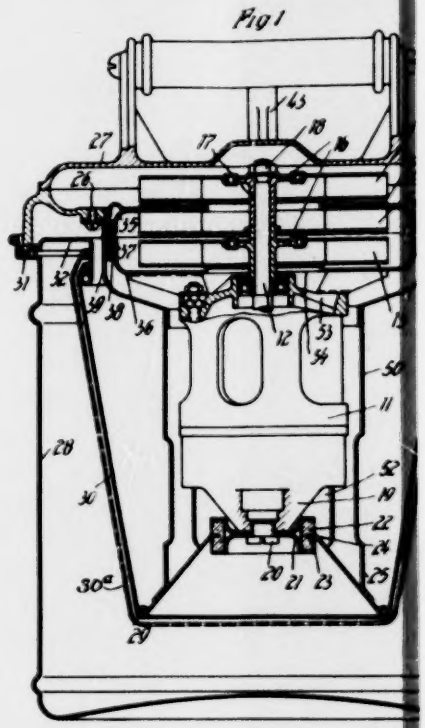


Aug. 8, 1933. K. KORITTKE

ELECTRICAL VACUUM CLEANER

Filed Sept. 14, 1931

Fig 1



R. 308

R. 316

THE PRIOR ART

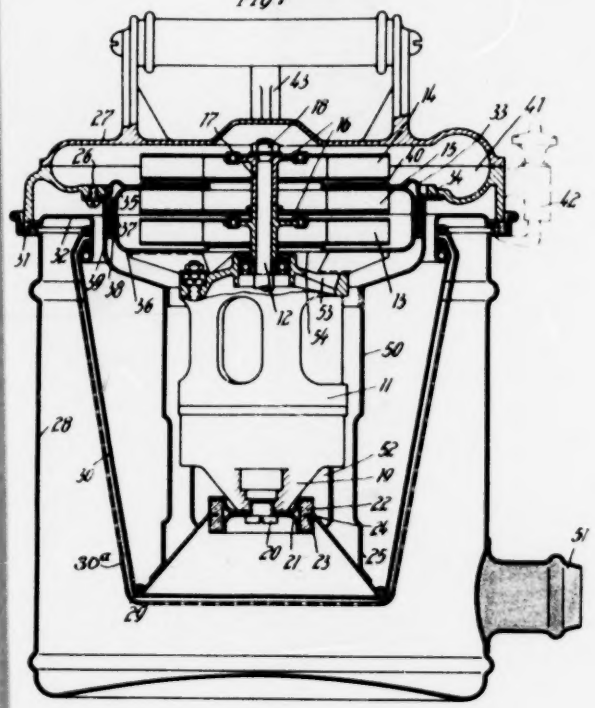
EVERY FEATURE OTHER THAN THE INTAKE NOZZLE "ADJACENT TO AND PARALLEL WITH THE FILTER SURFACE" IS SHOWN IN PRIOR ART PATENTS, WHICH COMPELLED THE INSERTION OF THE LIMITATIONS IN THE CLAIMS OF THE PATENT IN SUIT AS A PREREQUISITE TO THEIR ALLOWANCE BY THE PATENT OFFICE.

1933. K KORITTKE 1,921,085

ELECTRICAL VACUUM CLEANER

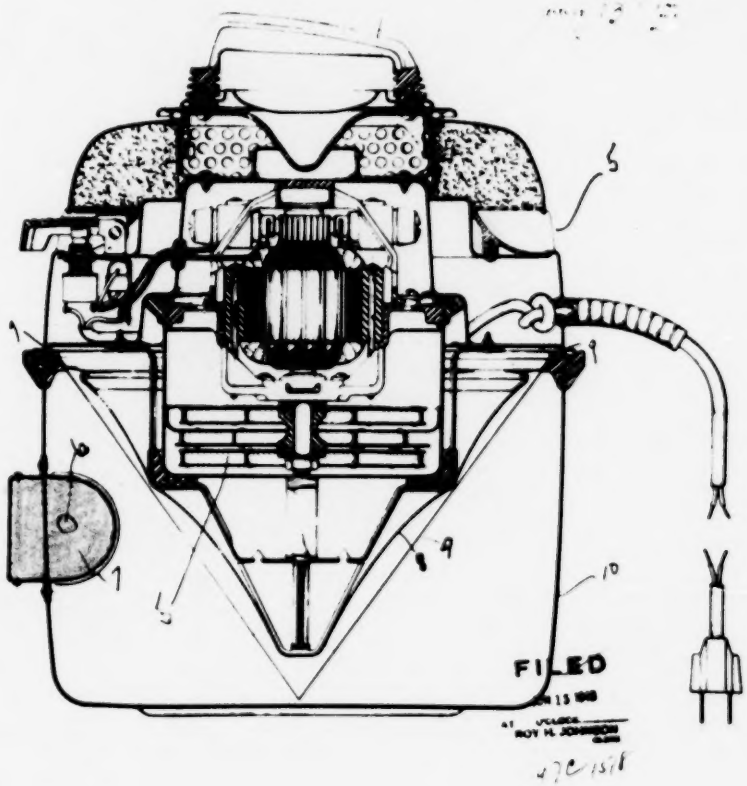
Filed Sept. 14. 1931 2 Sheets-Sheet 1

Fig 1



R. 316

LEWYT COMMERCIAL CLEANER



THE ACCUSED STRUCTURE HAS ITS AIR INTAKE REMOTE FROM AND DIRECTED AWAY FROM THE FILTER SURFACE, NEITHER ADJACENT THERETO NOR PARALLEL THEREWITH (R. 241)

Office - Supreme Court, U. S.
FILED
AUG 5 1950
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. 182

LEWYT CORPORATION,
Petitioner,

vs.

HEALTH-MOR, INC. and EDWARD H. YONKERS, JR.,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

MAX W. ZABEL,
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ROBERT L. KAHN,
Of Counsel.

The Scheffer Press, Inc.—FInancial 6-2694

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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

STATEMENT.

The petition misstates the decision of which review is sought. It misstates the history of both the litigation and the patent, and the matter involved. Not one of the questions alleged to be presented is supported in the record. The reasons relied on for the issuance of the writ either do not exist or are without merit.

There is no foundation for the introductory statement under the heading of "Matter Involved" (top p. 3) that "petitioner was forced to bring this declaratory judgment action by respondents' tactics in threatening but not suing petitioner's customers * * *." Respondents had notified only one of petitioner's customers and had received no response when petitioner began suit a few days

later. The second cause of action stated in the complaint which was directed to this subject was dismissed at the trial on motion of petitioner (R. 23).

The invention of the Yonkers patent in suit lies in a novel combination of elements providing a bagless, canister or pail type of suction cleaner, in which a *disposable* paper filter conical in form is employed in a cylindrical container or pail. The dirt, removed by suction from the floor covering or other work surface, is introduced through an air intake or nozzle into the pail below the paper cone. This dirt is separated from the air by the whirling action of the dirt-laden air in association with the filtering action of the paper cone, and thereupon accumulated in the bottom of the pail (R. 346).

This cleaner has important advantages over prior art cleaners. In addition to performing an efficient and economical cleaning operation and dispensing with the bothersome bag of prior art cleaners, which had to be cleaned frequently (R. 248), the structure is such that the suction-generating unit and other parts including a removable top or cover are arranged as a removable group, which serves to maintain the filter in operative position.

The arrangement makes possible, upon removal of the cover, the convenient emptying into a rubbish container of the accumulated dirt and used paper filter from the bottom or pail portion of the machine (See illustrations of Respondent Health-Mor's *Filter Queen* made under this patent. Def. Exh. 19, 20, R. 244, 245; also Petitioner's infringing *Lewyt,* Def. Exh. 3, R. 219-230). This was impossible with the older types of cleaners.

This type cleaner was first commercially introduced under the name *Filter Queen* in 1940 (R. 248, 129) by Respondent Health-Mor operating under an exclusive license

from the patentee Yonkers. There had not previously been anything like it on the market (R. 248). As stated in the Memorandum of the District Court (R. 248; see also Findings of Fact 2, 3, R. 262):

> "It manufactured and sold a large number of the devices until the War stopped its operations in 1941. After the War it resumed operations and had sold, up to the time of trial, 150,000."

Petitioner did not introduce its *Lewyt* cleaner until July 1947 (Findings of Fact 1, R. 262). This is a substantial copy of the *Filter Queen,* except that a cloth cone supported by a metal frame is used instead of a perforated metal support for the paper cone. Upon introducing its *Lewyt* cleaner petitioner launched an extensive advertising campaign heralding it as *"new"* and *"revolutionary"* (R. 233, 234, 237, 239).

The petition erroneously represents the status of the claims of the Yonkers patent in suit (R. 216, 217). Claims 2, 4 and 7 are directed chiefly to that part of the structure in which the dirt is removed from the dirt-laden air. This includes a housing, a conical air filter forming a cover for the housing, a perforated member for supporting the filter, an intake through which dirt-laden air is introduced into the housing, and means for guiding or discharging the dirt-laden air in a direction generally adjacent to and parallel with the filter surface. The presence of each of these elements is apparent in the patent drawing (R. 214), petitioner's illustration of its *Lewyt* (R. 231), and respondent's illustration of its *Filter Queen* (R. 232).

Claim 8 is directed to a different feature of the invention, namely, an arrangement of the parts in which the suction generating means and the filter support are grouped to form a cover unit and support the filter element against collapse, and are removable as a unit to

enable the convenient emptying of the bottom or pail portion of the machine. This is illustrated in petitioner's circular (R. 224, 225), and respondent's circular (R. 245 next to last page).

Referring to the proceedings in the Patent Office in relation to claim 2 of the patent the petitioner erroneously states (bottom p. 3) that "in this claim the distance or relationship between the nozzle and the filter was clearly limited to one in which the nozzle was 'adjacent to and parallel with the surface'." The language of the claim is "said intake connection terminating in a nozzle for *discharging*[1] dirt-laden air adjacent to and parallel with the filter surface" (R. 216).

This limitation was clearly recognized by the Court of Appeals and given effect by it in applying claim 2 to petitioner's infringing machine (R. 348, 2nd and 3rd pars.)[2]. This is also true as to the somewhat different limitations of claims 4 and 7. The District Court made no finding to the contrary. The Court of Appeals properly held (R. 348, 2nd par.) that the claims were not limited to a particular form of nozzle as petitioner had contended and the District Court seemed to think (Finding of Fact 13). Claims in the application containing such a limitation were amended with the approval of the Examiner to eliminate it (R. 156, 179, 186, 188, 193).

The Court of Appeals in holding (R. 346, 348) the asserted claims valid and infringed merely gave effect to their express language consistently with the disclosure and teaching of the patent. *There was no resort to the doctrine of equivalents* or enlargement of scope of the claims nor any necessity therefor.

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[1] Emphasis supplied.

[2] **Lewyt Corp. v. Health-Mor, Inc. et al.**, 181 F. (2d) 855 (CCA 7).

The Findings of Fact of the District Court (R. 262) insofar as they relate to the questions of validity and infringement, with the exception of Finding 15 which is predicated on a demonstration of petitioner's machine in open court, were *based wholly on documentary evidence consisting of three prior art patents* (R. 344) which had been thoroughly considered and distinguished in the Patent Office during the pendency of the application upon which the patent in suit issued (Pl. Exh. 1, R. 153, 161, 192; R. 345, last par.). The *same documentary evidence* on which the Findings of Fact are based was before Patent Office, District Court and Court of Appeals. Finding 15, which relates to the question of infringement only, requires no comment beyond what was said by the Court of Appeals (R. 349, last par.). *In no instance did those findings depend on conflicting testimony of experts or others.*

The Questions Presented are Not Supported in the Record.

Question 1 assumes a state of facts which does not exist. No critical question of estoppel by file history limitation can be predicated upon the record in this case. Petitioner's structure does not lack, but on the contrary includes the so-called "distinguishing feature" present in the patent claims. The Court of Appeals, after carefully considering each of the prior art patents upon which petitioner relied (R. 346), as well as the infringing machine, properly so held, saying *"this is so clear as to defy contradiction."* It is obvious from the language of its opinion (R. 348, 349) that the Court of Appeals in so holding gave full effect to those limitations of the claims which were introduced by amendment and were not present in the cancelled claims cited by petitioner (R. 349, top).

Petitioner makes an obvious misstatement in saying (p. 4) that its intake discharges the air "as far away from the filter surface as possible." See Fig. 4 of Kirby Patent (R. 290), which shows a nozzle at the outer periphery, and which petitioner might have followed but did not.

That the air intake in petitioner's "Lewyt" cleaner does for every intent and purpose terminate "in a nozzle for *discharging* dirt-laden air *adjacent to and parallel with* the filter surface" within the meaning of claim 2, is apparent upon a mere inspection of petitioner's infringing device and the illustrations of it in the record taken from petitioner's advertising (Def. Exh. 3A, R. 228; Def. Exh. 4, R. 231; Def. Exh. 3, R. 219-230; Pl. Exh. 27, R. 70). This is also true as to "means for *guiding* the incoming dirt-laden air so that the air takes a *generally circular path generally parallel to the filter surface and adjacent thereto*" as required in claims 4 and 7 (See testimony of witness Yeomans, R. 109-113; Def. Exh. 13, identical with Pl. Exh. 26, R. 241; also testimony of witness Yonkers, R. 80, 87). The fact that the intake is secured to the wall of the housing is unimportant and not in issue.

The comparison of claim 2 of the patent with rejected claims 9 and 10 made in the chart appended to petitioner's brief is quite superficial and meaningless. Claims 9 and 10 were broad claims considered in the early stages of the case. There is no occasion for resorting to claims of such scope in applying the claims in suit to petitioner's structure.

The drawings appended to petitioner's brief do not alone fairly depict the structures to which they relate for the purposes of this case. The Court of Appeals properly held that the disclosures of the prior art patents

neither separately nor collectively meet the asserted claims nor affect their application to petitioner's cleaner, which petitioner widely advertised as "new" and "revolutionary."

Question 2, in the circumstances which have been pointed out, is a moot question.

Question 3 assumes a condition which has no basis in the record. There can be no question on the facts in this case involving the omission of an essential element of a patent claim.

The language of the Court of Appeals upon which Question 3 is predicated was plainly directed to the combination of claims 2, 4 and 7, and cannot in the circumstances be considered as applicable to the different and independently novel combination of claim 8. The form or arrangement of air intake to which the limitation of claims 2, 4 and 7 is directed, while it may be embodied in the structure to which claim 8 relates, is not, and could not properly be, an element or essential of this claim. The function of the air intake does not pertain to the subject-matter defined in the claim. It could not be a part of the removable group on the one hand and its co-operation with that group or any constituent thereof or any other element of the claim would be immaterial insofar as the arrangement or purposes of the claim are concerned.

The District Court did not separately apply to claim 8 the prior art patents upon which petitioner relied. There is no showing, no evidence, that they meet it and they plainly do not. There is nothing inconsistent with the decisions of this Court in the decision of the Court of Appeals holding it valid.

Question 4 also is based upon a false premise, already noted (p. 5, above) and more fully to be discussed (p.

9). There was no critical conflict of testimony. Moreover, the so-called "scientific" demonstrations were mere demonstrations of normal operation of the machine involved and in evidence in the case, such as are performed regularly by thousands of users.

The Reasons Relied on For Allowance of Writ are Insufficient.

The first reason is not substantial. It amounts to this: That one is entitled to the writ because he is a lone infringer; in other words, because everyone but him respects the patent. The Court will take judicial notice that there are a large number of manufacturers in the vacuum cleaner industry. It is implicit in petitioner's statement and supporting affidavits that petitioner is the only one of those manufacturers who has not respected the patent in suit.

The circumstances presented here are quite different from those presented in the cases cited by petitioner and in which the Court granted the writ. The situation is utterly unlike that which existed in the *Mackay* case. That case, as the Court noted (306 U. S. 89), involved world-wide public radio communication, a matter of great public importance.

There has been no showing that the vacuum cleaner industry is concentrated in the Seventh Circuit or that respondents, by virtue of their ownership of the patent in suit or otherwise, either dominate or threaten to dominate the industry or confine litigation involving the patent to the Seventh Circuit.

The second reason misrepresents the record in the case. The decision of the Court of Appeals does not conflict with the cited decisions of this Court. The Court of

Appeals, as has been shown in our discussion of Question 2, did not read claims 2, 4 and 7 to cover what was eliminated from the application upon which the patent in suit, issued, but fairly and properly applied the express language of those claims as embodied in the patent grant to petitioner's structure and held that that structure responded to that language. There was no revival of cancelled claims, no enlargement or expansion of claims by resort to equivalents.

As to claim 8, we have already pointed out in our discussion of Question 3, that the form or position of the air intake in relation to the conical filter is not an essential element of the combination to which this claim is directed. There is no similarity between the instant case and the *A & P* case, where the point is made that the prior art meets the claim unless the omitted element be read into it. There is nothing in the record here to support such a contention.

The third reason which corresponds to Question 4 does not exist. The Court of Appeals merely acted consistently with the generally accepted procedure in cases where the finding of invalidity is based on documentary evidence such as prior art patents, citing its own previous decision in *Chas. Peckat Mfg. Co.* v. *Jacobs,* 178 F(2) 794, in which this Court denied certiorari on March 13, 1950. See Docket No. 607, *Henry E. Jacobs* v. *Chas. Peckat Mfg. Co., et al.,* 339 U. S. 915; 94 L. Ed. 458. There is no conflict with decisions of this Court as to the weight to be accorded Findings of Fact of a trial court. Neither of the cases cited by petitioner is in point. In its opinion in the *Peckat* case the Court of Appeals expressly recognized the principle of the *Graver* case.

The fourth reason is without merit. The record in this case reflects no misunderstanding or confusion with respect to the question of file wrapper estoppel requiring consideration by this Court.

Respondents suggest that the petition does not present substantial grounds for the granting of the writ and request that it be denied.

Respectfully submitted,

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